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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79118868
Applicant	SF MODE
Applied for Mark	WANDERLUST
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
ON EX PARTE APPEAL

Applicant: SF Mode

Serial No. 79/118,868

Filed: August 16, 2012

Mark: WANDERLUST

Trademark Examining Attorney: Kelly Trusilo

Law Office: 107

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APPLICANT'S EX PARTE APPEAL BRIEF

Applicant respectfully files and submits this timely appeal to the Trademark Trial and Appeal Board from the Examining Attorney's final refusal under Trademark Act Section 2(d), 15 U.S.C. 1052(d) to register the above-referenced mark, WANDERLUST, for the following goods and services under the current understanding that the prior amendment of the goods and services clauses in the present application have been accepted as follows:

Pre-Recorded Disks, Tapes, And Compact Disks Featuring Music, Musical Performances, And Fitness, Wellness, And Recreational Content; Audio Devices, Namely, MP3 Players; Audiovisual Devices, Namely, CD Players And DVD Players; Sound, Video, And Data Recordings In The Form Of Disks Featuring Music, Musical Performances, Entertainment Performances, Comedy Performances, Documentaries, Films, Fitness And Wellness Programs, Civic, Socially Beneficial, And Recreational Programs; Apparatus For Recording Sounds; Blank Magnetic Recording Media, Namely, Sound Recording Disks And Optical Disks, And Audio-Video Compact Disks in International Class 009;

Entertainment Services In The Nature of Live Musical Concerts, Live Musical Performances, Plays, Comedy Routines, Fitness, Wellness, Entertainment, Civic, Social, And Recreational Performances; Discotheque Services; Night Club Services; Providing Online Non-Downloadable Electronic Publications In The Nature Of Reviews In The Field Of Music, Cultural Exhibitions, Current Affairs, Political Topics, Fitness, Wellness, Social, Civic, And Recreational Activities; Providing Amusement Arcade Services; Game Services Provided On-Line From A Computer Network; Publication Of Books Or Periodicals; Leisure Services, Namely, Organization Of Cultural Exhibitions, Musical Performances, Providing Karaoke Services; Music-Halls; Organization Of Balls; Organization Of Sports Competitions For Entertainment; Organization Of Shows, Namely, Fashion Shows, Fitness Shows, Wellness Shows; Party Planning; Theater Productions; Operation Of Movie Theaters; Operation Of Concert Halls, Night Clubs; Organization Of Art Work Exhibitions For Cultural Purposes; Cinematographic Film Projection; Organization Of Concerts; Organization Of Conferences In The Field Of Music, Cultural Exhibitions, Current Affairs, Political Topics, Fitness, Wellness, Social, Civic, And Recreational Activities in International Class 041; and

Providing Food And Drink; Food And Drink Catering; Providing Temporary Housing Accommodation, Bar Services in International Class 043

It has been the Examining Attorney's contention that there is a likelihood of confusion between Applicant's mark and (i) the cited U.S. Reg. No. 3,880,519 ("the '519 registration") for WANDERLUST for registered goods in International Class 009 consisting of "Audio and video recordings featuring entertainment in the nature of music, lectures on fitness, exercise, yoga and music, interviews on fitness, exercise, yoga and music, or fitness, exercise and yoga instruction, **all of which relate to a festival featuring these activities**" [emphasis added]; (ii) the cited U.S. Reg. No. 3,880,423 ("the '423 registration") for WANDERLUST for registered services consisting of "Arranging and conducting nightclub entertainment events; Concert booking; Conducting entertainment exhibitions **in the nature of live music festivals**; Entertainment, namely, live music concerts" [emphasis added]; and (iii) the cited U.S. Reg. No. 4,092,974 ("the '974 registration") for WANDERLUST for registered services in International Class 041

consisting of “Production of streaming video and website development in the fields of yoga, music, and entertainment; providing an on-line computer database in the fields of music, yoga and entertainment; educational services, providing instruction, studios, conferences, workshops, professional trainings and retreats in the fields of yoga, meditation, spiritual attunement, exercise and aerobic fitness, diet and nutrition, stress management and relaxation, outdoor recreation, holistic health care, preventative health care, alternative health care, therapeutic massage and alternative healing; electronic publishing services, namely, publishing of online works of others featuring user-created text, audio, video, and graphics; providing on-line journals and web logs featuring user-created content in the fields of music, yoga, and entertainment.”

Based upon the ex parte record and the arguments contained herein, Applicant respectfully asserts that the Trademark Examining Attorney’s contention to be in error and respectfully requests this Board to reverse the refusal and allow the Applicant’s mark to be published for opposition upon the Principal Register for all three (3) of the goods and services classes set forth in the present application on appeal.

In the alternative to the requested reversal of the Trademark Examining Attorney’s final refusal of the present application on appeal in all three (3) classes, Applicant respectfully submits that, consistent with the payment of Ex Parte Appeal fee for all three (3) classes, that reversal of at least the Applicant’s services in International Class 043 for “Providing Food And Drink; Food And Drink Catering, Providing Temporary Housing Accommodation, Bar Services” is particularly warranted since none of the cited registrations even tangentially touch upon these services.

On this point relating to Applicant's services clause in International Class 043, Applicant additionally requests the Trademark Examining Attorney to consider taking action under TMEP 1501.03 to withdraw the refusal as to at least the Applicant's services in International Class 043 consisting of "Providing Food And Drink; Food And Drink Catering, Providing Temporary Housing Accommodation, Bar Services."

I. FACTUAL BACKGROUND

On August 16, 2012, Applicant filed its application to register WANDERLUST before the U.S. Patent & Trademark Office based upon the provisions of Section 66A of the Act. During the course of ex parte examination, Applicant amended its requested goods and services to reflect the following:

Pre-Recorded Disks, Tapes, And Compact Disks Featuring Music, Musical Performances, And Fitness, Wellness, And Recreational Content; Audio Devices, Namely, MP3 Players; Audiovisual Devices, Namely, CD Players And DVD Players; Sound, Video, And Data Recordings In The Form Of Disks Featuring Music, Musical Performances, Entertainment Performances, Comedy Performances, Documentaries, Films, Fitness And Wellness Programs, Civic, Socially Beneficial, And Recreational Programs; Apparatus For Recording Sounds; Blank Magnetic Recording Media, Namely, Sound Recording Disks And Optical Disks, And Audio-Video Compact Disks in International Class 009;

Entertainment Services In The Nature of Live Musical Concerts, Live Musical Performances, Plays, Comedy Routines, Fitness, Wellness, Entertainment, Civic, Social, And Recreational Performances; Discotheque Services; Night Club Services; Providing Online Non-Downloadable Electronic Publications In The Nature Of Reviews In The Field Of Music, Cultural Exhibitions, Current Affairs, Political Topics, Fitness, Wellness, Social, Civic, And Recreational Activities; Providing Amusement Arcade Services; Game Services Provided On-Line From A Computer Network; Publication Of Books Or Periodicals; Leisure Services, Namely, Organization Of Cultural Exhibitions, Musical Performances, Providing Karaoke Services; Music-Halls; Organization Of Balls; Organization Of Sports Competitions For Entertainment; Organization Of Shows, Namely, Fashion Shows, Fitness Shows, Wellness Shows; Party Planning; Theater Productions; Operation Of Movie Theaters; Operation Of Concert Halls, Night Clubs; Organization Of Art Work Exhibitions For Cultural Purposes; Cinematographic Film Projection; Organization Of Concerts; Organization Of Conferences In The Field Of

Music, Cultural Exhibitions, Current Affairs, Political Topics, Fitness, Wellness, Social, Civic, And Recreational Activities in International Class 041; and

Providing Food And Drink; Food And Drink Catering; Providing Temporary Housing Accommodation, Bar Services in International Class 043

On July 10, 2014, the Trademark Examining Attorney issued a Final Office Action refusing each and all of Applicant's above requested goods and services clauses based upon the cited '519, '423, and '974 registrations. On January 9, 2015, Applicant requested reconsideration of the Final Office Action, which was denied on February 10, 2015.

II. LEGAL BACKGROUND

On January 26, 2015, subsequent to the Applicant's January 9, 2015 request for reconsideration of the July 10, 2014 Final Office Action, the Trademark Trial & Appeal Board issued its precedential decision and opinion of *In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015), which Applicant now cites and explicitly relies upon in the present appeal. As set forth more fully below in the present Appeal Brief, Applicant submits that there is no likelihood of confusion with the cited '519, '423 and '974 registrations because of the number and nature of similar marks in use on similar goods and the sophistication of the relevant consumers of these goods and services. Once again, as requested in the alternative, these distinctions are most pronounced when examining Applicant's requested services in International Class 043 consisting of: Providing Food And Drink; Food And Drink Catering; Providing Temporary Housing Accommodation, Bar Services. Most simply stated, these services are not found within any of the cited '519, '423, and/or '974 registrations in any form whatsoever, related or unrelated.

In presenting the arguments and basis for this ex parte appeal, also explicitly relies upon TMEP 1207.01(a)(iii) which states: “The nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration.” [emphasis added]. Applicant further states that the Federal Circuit has also long embraced this doctrine. See *Octocom Syst. Inc. v. Houston Computer Svcs. Inc.*, 16 USPQ2d 1783, 1787 (Fed.Cir. 1990) (“the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchaser’s to which sales of the goods are directed.”). Here, with great respect, and notwithstanding the substance of Attachments 1-12 accompanying the July 10, 2014 Final Office Action, the goods clause set forth in the cited ‘519 registration itself contains an explicit limitation for the goods to be “all of which relate to a festival featuring these activities” with a similar limitation set forth in the cited ‘423 registration. In other words, the “festival” limitation is set forth in at least two of the cited registrations themselves.

As such, the relevant question is not whether the specific goods of Applicant and Registrant are actually marketed in the same trade channels. It is whether goods of the types identified in the application and the cited registration are typically marketed in the same or related channels. The explicit limitation or arguable “carve-out” that the cited registrations comprise goods “all of which relate to a festival featuring these activities” would negate any presumptions relied upon the Trademark Examining Attorney to sustain the rejection and require both an analysis and focus on the “festival” limitation.

As shown at Exhibit A hereto, the Merriam-Webster online dictionary (the same reference used by the Trademark Examining Attorney, July 10, 2014 Final Office Action, Attachment 1) defines “festival” as “a special time or event when people gather to celebrate something”, “an organized series of performances”, “a time of celebration or program of events or entertainment having a specific focus.” The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. See *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006). Under any of these definitions, it is clear that at least the cited ‘519 and ‘423 registrations are specifically attenuated to providing the relevant goods or services at a discrete and temporal event having a specified focus – all of which rather undeniably impact at least the similarity of goods, channels of trade, and sophistication of purchaser factors in the underlying Section 2(d) analysis. At its core, the Trademark Examining Attorney respectfully committed error in issuing the final refusal of the Applicant’s goods and services by failing to address these limitations in the cited registrations, the absence of any reference to Applicant’s requested services in at least International Class 043, and concluding that the traditional presumptions apply when both TMEP 1207.01(a)(iii) and applicable Federal Circuit precedent dictate that they cannot.

More particularly, if TMEP 1207.01(a)(iii) is to have any relevance, this is not a situation where the Examining Attorney can rely upon a legal presumption(s) as the recited goods and services differ on their face. Rather, this is more akin to a situation where the services are clearly articulated and attenuated to different functions, needs, and purchasers within, at best, the same generalized industry or market.

Notably, just as consumers of arguably similar edible confections were able to distinguish between the mark, TIC TAC, for candy with no likelihood of confusion with TIC TAC TOE for ice cream in *In re P. Ferrero & C. Spa.*, 479 F.2d 1395, 178 USPQ 167, 168 (CCPA 1973) and COPPER CLAD for composite metal wire material having an aluminum core clad with copper for use in electrical conductors is not likely to cause confusion with COPPERCLAD for copper coated carbon electrodes for use in electric arc cutting and gouging in *In re Texas Instruments Inc.*, 193 USPQ 678 (TTAB 1976), the differences between Applicant's recited goods and services above, when compared to the cited registrations – as registered and properly compared under TMEP 1207.01(a)(iii) – equally dictate that an even more discriminating consumer with full desire and knowledge to enter into a contractual relationship to purchase a discrete good or perform a discrete service (such as the present class of purchasers) would be able to distinguish between Applicant's goods and/or services and the explicit "festival" nature of at least the cited '519 and '423 registrations which is a discretely timed event "having a specified focus". See Exhibit A hereto.

Indeed, placed in the proper context of TMEP 1207.01(a)(iii), it is submitted that an examination of the pending goods clause in International Class 009 and the services clause(s) in each of International Class 041 and International Class 043 also serve to highlight and demonstrate similar cognizable differences in the goods/services set forth in the three (3) specific registrations cited by the Trademark Examining Attorney. Notably, none of the cited registrations even tangentially relate or comprise any aspect of the Applicant's requested goods or services clauses, and particularly the services in

International Class 043 comprising: Providing Food And Drink; Food And Drink Catering; Providing Temporary Housing Accommodation, Bar Services. On this point, no aspect of the cited registrations, on their face, arguably even suggest the provision of services in the nature of Applicant's services of: Providing Food And Drink; Food And Drink Catering; Providing Temporary Housing Accommodation, and/or Bar Services – whether or not they are part of a “festival.”

Further, based upon the Applicant's prior response and continued herein, it is also highly relevant that WANDERLUST is a relatively weak mark that has been adopted, registered, and used by many third parties for a variety of goods and services. Thus, Applicant's good faith reliance upon TMEP 716.03 is respectfully maintained and reiterated. See *In re Hartz Hotel Services Inc.*, 102 USPQ 1150, 1155 (TTAB 2012) (Board relatively recently found that consumers are able to distinguish between different GRAND HOTEL marks based on small differences in the marks, in part, because of the highly suggestive nature of GRAND HOTEL).

“It seems logical and obvious to us that where a party chooses a Trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.”

In re Hunke & Jocheim, 185 USPQ at 189.

Applicant requests that its present application for WANDERLUST be compared and viewed in this framework to each of the cited '519, '423, and '974 registrations. The Examining Attorney maintained the Section 2(d) rejection on the basis that “a

relationship exists between the goods and services of each party such as to produce a likelihood of confusion given the identical nature of the marks.” Given the limitations of TMEP 1207.01(a)(iii), coupled with TMEP 716.03, Applicant respectfully asserts that more than such a tangential relationship is needed in this case to maintain the present Section 2(d) rejection and, in its absence, mandates reversal on appeal.

III. SUMMARY OF SECTION 2(d) ARGUMENTS

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks”). “However, the identity of the marks alone is not sufficient to establish likelihood of confusion in the absence of probative evidence that the goods are related. If that were the case, then the Registrant would have rights in gross, and that is against the principles of trademark law. ‘In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of *all* the evidence, whether or not confusion appears likely.’” *In re Thor Tech* citing *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388, 1392 (Fed.Cir. 1992) quoting *In re E.I. DuPont de Nemours & Co.*, 177 USPQ at 568.

With great respect to the Trademark Examining Attorney, reversal is warranted where, as here:

- (1) the cited ‘519 registration for WANDERLUST, on its face, is limited to registered

goods of “Audio and video recordings featuring entertainment in the nature of music, lectures on fitness, exercise, yoga and music, interviews on fitness, exercise, yoga and music, or fitness, exercise and yoga instruction, **all of which relate to a festival featuring these activities.**” Thus, the registered goods clause in the cited ‘519 registration itself contains a self-limitation to a festival or specific event where those goods are expressly provided thereby implicating the narrowing restrictions of at least TMEP 1207.01(a)(iii). As most recently stated in footnote 8 of *In re Thor Tech*, just as the Board “cannot countenance an applicant’s attempt to show that a registrant’s actual usage is narrower than the statement of the goods in the registration”, it is respectfully submitted that the Trademark Examining Attorney should not be allowed to impermissibly broaden the scope of the cited registration beyond the clearly pronouncing “festival” limitation;

(2) the cited ‘423 registration for WANDERLUST, on its face, is limited to “Arranging and conducting nightclub entertainment events; Concert booking;

Conducting entertainment exhibitions in the nature of live music festivals;

Entertainment, namely, live music concerts.” Again, the registered services clause in the cited ‘423 registration itself contains self-limitations to a festival or specific event that, respectfully, Applicant has absolutely no relationship with, are fully distinguishable from the Applicant’s goods/services thereby implicating the narrowing restrictions of at least TMEP 1207.01(a)(iii), and further supports Applicant’s position regarding the differences in the channels of trade and sophistication of consumers;

(3) the cited ‘974 registration for WANDERLUST, in its entirety, is limited to

services which are clearly defined to be in the area of website development, on-line computer database content, and even defined computer services recited as: “Production of streaming video and website development in the fields of yoga, music, and entertainment; providing an on-line computer database in the fields of music, yoga and entertainment; educational services, providing instruction, studios, conferences, workshops, professional trainings and retreats in the fields of yoga, meditation, spiritual attunement, exercise and aerobic fitness, diet and nutrition, stress management and relaxation, outdoor recreation, holistic health care, preventative health care, alternative health care, therapeutic massage and alternative healing; electronic publishing services, namely, publishing of online works of others featuring user-created text, audio, video, and graphics; providing on-line journals and web logs featuring user-created content in the fields of music, yoga, and entertainment.” The scope and content of the registered services clause in the cited ‘974 registration differs greatly from the Applicant’s proposed services in International Class 041, and certainly the Applicant’s proposed services in International Class 043. Here, the technically-oriented services clause in the ‘974 registration is distinguishable from the Applicant’s goods/services thereby implicating the narrowing restrictions of at least TMEP 1207.01(a)(iii);

(4) Under TMEP 1207.01(a)(iii), the cited ‘519 and ‘423 registrations are clearly directed to a class of purchaser desiring to seek out and attend the “festival” event whereas the ‘974 registration effectively provides online content and computer database services to others, which are not even tangentially at issue in the present application; and

(5) even if the Board is not persuaded by these arguments concerning the apparent

distinctions between the Applicant's goods clause in International Class 009 and the Applicant's services clause in International Class 041 in the present application, the fact remains that no aspect of the cited '519, '423, or '974 registrations suggest, even remotely, to have any connection with the Applicant's services clause set forth in International Class 043 consisting of Providing Food And Drink; Food And Drink Catering; Providing Temporary Housing Accommodation, Bar Services. Applicant requests the alternative relief of reversal of the Final Rejection as applied to at least the services clause in International Class 043 or unilateral action by the Trademark Examining Attorney to withdraw this Section 2(d) rejection under TMEP 1501.03.

IV. SECTION 2(d) ARGUMENTS & CITATION TO TMEP 716.03

Subsequent to both the July 10, 2014 Office Action setting forth the final refusal of the present appealed application under Section 2(d) based upon the cited '519, '423, and '974 registrations and Applicant's January 9, 2015 request for reconsideration, the Board issued a precedential opinion found at *In re Thor Tech, Inc.*, 113 USPQ2d 1546 (TTAB 2015), which Applicant submits is applicable, relevant, and useful in the analysis of the present Section 2(d) analysis. First, Applicant respectfully submits herein that in refusing the present application based upon the cited '519, '423, and '974 registrations, the Trademark Examining Attorney has committed reversible error by affording each of the cited registration(s) far too broad a scope of protection from the standpoint of all of the arguably relevant factors of: (1) the strength of the mark(s); (2) the similarity of the goods/services (as actually registered in each of the cited '519, '423, and '974 registrations) compared to the present application on appeal; (3) the sophistication of the

relevant purchasers who would actually contract for such goods/services and attend the discrete “festival” events; and (5) the applicable channels of trade of such goods and services, especially where at least the ‘519 and ‘423 registrations expressly relate to a “festival” provision of the relevant goods and services. It is submitted that the goods and services set forth in the present application on appeal (and especially the services set forth in International Class 043) are not “legally” identical to those set forth in the cited registrations and cannot thereby create any presumption which discharges the continuing mandate under Section 2(d) to consider all of the relevant “likelihood of confusion” factors. In short, this is not a situation where the present goods or services can be described as legally identical to the cited goods/services and thereby relieve the Trademark Examining Attorney from evaluating the channels of trade, the sophistication of purchasers, and other relevant arguments. Under TMEP 1207.01(a)(iii): “The nature and scope of a party’s goods or services **must** be determined on the basis of the goods or services recited in the application or registration.” [emphasis added].

Under *In re Hartz Hotel Services Inc.*, 102 USPQ 1150, 1155 (TTAB 2012), when the common use of WANDERLUST is appreciated, it is clear that any possibility of confusion is extremely unlikely, and the refusal under Section 2(d) should be withdrawn, based upon the over forty (40) year old precedent of *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974) discussed herein on this issue. Here, the documented weak nature of WANDERLUST and the clear differences in the cited goods and services, strongly supports reversal in the present ex parte appeal.

1. There is No Likelihood of Confusion with the Cited Registration(s)

It is well-settled that the test for determining likelihood of confusion under Section 2(d) is the same "likelihood of confusion" rule applicable to the test of trademark infringement. *Glenwood Laboratories, Inc. v. American Home Products Corp.* 173 USPQ 19 (CCPA 1972). When the appropriate factors are considered, a different outcome than that reached by the Trademark Examining Attorney is respectfully required. In particular, when considered in the context of the numerous coexisting marks dominated by the same term, WANDERLUST, it is clear that the cited ‘519, ‘423, and ‘974 registrations for WANDERLUST not only contain differences in the services as registered under TMEP 1207.01(d)(iii), but in actuality each of the cited registrations is/are entitled to only a narrow scope of protection. When properly appreciated as a weak mark due to the crowded nature of the field, it is clear that no confusion with Applicant's mark is likely.

In particular, as can be seen from a search of the TESS system from the USPTO database, the cited ‘519, ‘423, and ‘974 registration(s) exist and indeed, coexist, among numerous other active and/or registered third party marks which incorporate the same term "WANDERLUST" for a variety of goods and services. For purposes of reliance on TMEP 716.03, each of the third party marks set forth below are believed to be active AND include the relevant term WANDERLUST. By way of example only, and only confining this discussion to purely prior third party filings of WANDERLUST, the following records from the USPTO database provide strong evidence that the cited mark is weak inasmuch as it exists in an extremely crowded field:

Word Mark	Reg./Serial No.	Recited Goods & Services
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Word Mark	Reg./Serial No.	Recited Goods & Services
WANDERLUST	1,961,144	Shoes; Boots
WANDERLUST AND LIPSTICK	3,526,235	Books In The Field Of Travel; Educational Books Featuring Travel; Manuscript Books; Travel Books
POETIC WANDERLUST	4,295,609	Accent Pillows
WANDERLUST	3,825,752	Brand Imagery Consulting Services, Advertising, And Marketing Consulting Services
WANDERLUST	3,511,635	All Purpose Sport Bags; All-Purpose Carrying Bags; Baby Carrying Bags; Bags For Carrying Babies' Accessories; Backpacks, Book Bags, Sports Bags, Bum Bags, Wallets And Handbags; Beach Bags; Belt Bags And Hip Bags; Canvas Shopping Bags; Cosmetic Bags Sold Empty; Toiletry Bags Sold Empty; Diaper Bags; Duffel Bags; Shopping Bags With Wheels Attached; Billfolds; Briefcases And Attache Cases; Luggage; Luggage Tags; Straps For Luggage; Umbrellas
WANDERLUST BREWING CO	85/679,384	Beer
WANDERLUST	85/634,581	Cosmetics
WANDERLUST BURGER BAR	86/437,557	Bar And Restaurant Services
SOUTHERN WANDERLUST	86/446,965	On-Line Retail Store Services Featuring Clothing And Accessories; Retail Clothing Boutiques; Retail Store Services Featuring Clothing And Accessories

Applicant relies upon the recent 2015 *In re Thor Tech* precedential opinion to

demonstrate that the Board has previously relied on similar evidence as weighing against confusion. “In *Keebler Company v. Associated Biscuits Limited*, 207 USPQ 1034 (TTAB 1980), we said:

... In this sense, registrations tend to define fields of use and, conversely, the boundaries of use and protection surrounding the marks and marks comprising the same word ... for their various products. The mutual respect and restraint exhibited toward each other by the owners of the plethora of marks, evidenced by their coexistence on the Register, are akin to the opinion manifested by knowledgeable businessmen”

Id. at 1038.

“While *Keebler* involved numerous third-party registrations incorporating the word ‘Club,’ the Board noted that ‘[t]he pattern of registrations does, however, exemplify long-standing and extensive practice within the Patent and Trademark Office and, necessarily, equally long-standing beliefs ... of business people that the uses of those marks would be feasible and helpful in their businesses.’” It is Applicant’s position on appeal that the documented presence of the “festival” self-imposed limitation in the cited ‘519 and ‘423 registrations, coupled with the unrelated technical services in the cited ‘974 registration, and the clear “pattern of registrations” owned, registered, and used by multiple third parties for a wide variety of third party goods and services is likewise sufficient for the Board to conclude that the “pattern of registrations” inference can be relied upon here to support a finding weighing against any “likelihood of confusion” as the cited registrations are but a sample of the existing and multiple WANDERLUST uses.

This analysis requires that the third party uses and registrations discussed herein,

as well as the cited '519, '423, and '974 registrations, all be placed in their proper context: they exist in an extremely crowded field, and are entitled to only narrow protection. See also *King Candy Co. v. Eunice King's Kitchen Inc.*, 182 USPQ 108 (CCPA 1974) (when marks are widely used, the public easily distinguishes slight differences among them as well as between the goods). See also, *Sure Fit Products Co. v. Saltzson Drapery Co.*, 117 USPQ 295 (CCPA 1958). Accordingly, the above evidence of the numerous third party filings and registrations is a strong argument undermining the basis for the Trademark Examining Attorney's conclusion of a likelihood of confusion, especially where there are clear differences in the application, function, and result of the services clauses set forth in the present application when compared to the differing goods and services in each of the cited '519, '423, and '974 registrations.

Such evidence is clearly relevant to the consideration of the instant application. Indeed, in the Federal Circuit case of *Lloyd's Food Products Inc. v. Eli's Inc.*, 25 USPQ2d 2027 (Fed. Cir. 1993), the court reversed a decision of the TTAB for failing to consider evidence of extensive third party usage in connection with the argument that a registered mark was weak and entitled to only narrow protection, and therefore unlikely to confuse. Further, as the CCPA held in *Sure Fit Products Co. v. Saltzson Drapery Co.*, 117 USPQ 295 (CCPA 1958), "[w]here a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights." See *General Mills Inc. v. Kellogg Co.*, 3 USPQ2d 1442 (8th Cir. 1987) (the weaker the mark, the less junior uses that will trigger a likelihood of confusion.) See also, *Telemed Corp. v. Tel-Med Inc.* 200 USPQ 427 (7th Cir 1978). See generally,

McCarthy, *Trademarks and Unfair Competition*, D 11:76. Applicant relies upon this same reasoning given the multiplicity of WANDERLUST uses by many third parties and the existence of multiple such WANDERLUST registrations before the U.S. Patent & Trademark Office set forth above. Likewise, in *Jupiter Hosting Inc. v. Jupitermedia Corp.*, 76 USPQ2d 1042 (N.D. Cal. 2004), the court emphasized that "where a plaintiff's mark resides in a crowded field, 'hemmed in on all sides by similar marks on similar goods,' that mark is weak as a matter of law," citing *PostXCorp. v. docSpace Co., Inc.* 80 F. Supp. 2d. 1056, 1061 (N.D. Cal. 1999). While the numerous third party "WANDERLUST" registered marks have coexisted with each other for years, there is no question that the marks shown in the cited '519, '423 and '974 registrations is/are hemmed in on all sides, and weak as a matter of law. With this in mind, particular attention must be paid to the differences which exist between the marks and their respective goods/services, all of which take on a heightened significance when and where, as here, there is a demonstrated multiplicity of registered uses of the same mark (i.e. WANDERLUST) by a multiplicity of third party users.

2. There Are Cognizable Differences In The Applicable Goods/Services

Turning to the issue of the comparison of the cited goods/services, it is also well settled in trademark law that, to establish a likelihood of confusion, the goods or services to be compared must be more related in their manner of marketing than merely presenting *a remote possibility* that a consumer would encounter both. For example, in *EDS Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460 (TTAB 1992), the Board concluded that even where both parties' goods were software, the goods were not necessarily

sufficiently related to support a conclusion of likelihood of confusion, even with nearly identical marks such as EDS and EDSA. The TTAB held "the fact that both parties provide computer programs does not establish a relationship between the goods or services, such that all computer software programs emanate from the same source simply because they are sold under similar marks." Even lip balm and deodorant, both personal care products, were not found to be sufficiently related to cause confusion when sold under identical marks, for the reason that the products "do not compete nor serve the same purpose ..." *WWW Pharmaceutical Co. Inc. v. The Gillette Co.*, 25 USPQ2d 1593 (2d Cir. 1992). Similarly, the Board refused to find the goods closely enough related to confuse even when the identical mark, LITTLE PLUMBER, was used contemporaneously for plumbing products such as drain openers, and plumbing advertisements for plumbing contractors. *Local Trademarks, Inc. v. The Handy Boys, Inc.*, 16 USPQ2d 1156 (TTAB 1990).

The Board is respectfully directed to a strong line of cases, cited by the TMEP, which stand for the proposition that even identical marks may be found not confusing as used on *related goods* where the differences in meanings contribute to different commercial impressions. As clearly set forth in TMEP 1207.01(b), "even marks which are identical in sound and/or appearance may create sufficiently different commercial impressions when applied to the respective parties' goods so that there is no likelihood of confusion." Thus, CROSS-OVER for bras was held not likely to be confused with CROSSEVER for ladies' sportswear, even in view of the "undeniable" close relationship of the goods, given the significant difference in meanings of the marks as applied to the

respective underlying goods. *See also In re Sears, Roebuck and Co.*, 2 USPQ2d 1312 (TTAB 1987). Similarly, BOTTOMS UP for ladies' and children's underwear was held not confusingly similar to the identical mark BOTTOMS UP for men's clothing. *In re Sydel Lingerie Co., Inc.*, 197 USPQ 629 (TTAB 1977).

Moreover, in *Jerrold Electronics Corp. v. The Magnavox Co.*, 199 USPQ 751,758 (TTAB 1978), the Board relied on the coexistence of several similar registrations as grounds for allowing a newcomer: “These registrations reflect a belief, at least by the registrants, who would be most concerned about avoiding confusion and mistake, that various STAR marks can coexist provided there is a difference:... Applicant's STAR mark is simply another variation of the theme which we do not believe will give rise to any likelihood of confusion, mistake or deception.”

Given the weakness of the WANDERLUST mark, as demonstrated and documented by the multiplicity of third party registrations under TMEP 716.03, there is no question but that the public in general is conditioned to, and indeed is capable of, distinguishing between marks with the same degree of similarity here. On this exact point, Applicant reiterates its reliance upon the provisions and protections of TMEP 1207.01(a)(iii) that the scope of protection afforded to the cited registrations should be limited to the specific goods/services clause actually registered by the registrant(s).

Most notably, this is particular apparent and demonstrable in the context of the Applicant's present services in International Class 043, but all of the Applicant's goods and services are directed to sophisticated purchasers who would comprehend and understand the differences between attending a discrete “festival” event.

3. Sophistication Of The Relevant Purchasers Of The Goods/Services

There is no likelihood of confusion because the purchasing conditions for Applicant's goods and services in comparison to the discrete goods set forth '519 registered goods in International Class 009 of "Audio and video recordings featuring entertainment in the nature of music, lectures on fitness, exercise, yoga and music, interviews on fitness, exercise, yoga and music, or fitness, exercise and yoga instruction, all of which relate to a festival featuring these activities since the relevant purchaser(s) would command discrimination and studied selectivity or, at least, cognitively distinguish between the provision of an event, such as a festival which by definition takes place in a finite, fixed, or discrete time period . In this case, the nature of the discriminating consumer of the goods or services at issue (i.e. relating to a festival), which is itself highly-regulated and requires permits, licenses, etc. for the provision and sale of any such goods and services, further bolsters the conclusion that no likelihood of confusion exists. Most notably, a user and relevant purchaser who either attends or is attracted to a "festival" event would be cognitively drawn to the subject matter of the festival as a point of personal interest and would thereby "know" that what they are selecting and contracting for is related to the festival.

Courts and the TTAB have routinely held that the type of sophisticated purchaser who will be involved in the purchase of Registrants' and Applicant's respective goods and services would exercise a greater degree of care in entering into purchase transactions since the consumer has a "reasonably focused need" or "specific purpose" involving the relevant goods or services. *Hayden Switch & Instrument v. Rexnord, Inc.*, 4

USPQ2d 1510 (D. Conn. 1987). *Washington National Insurance Co. v. Blue Cross and Blue Shield United of Wisconsin*, 772 F.Supp. 472 (N.D. Ill. 1990); See also *Societe Anonyme de la Grande Distillerie E. Cusenier Fils Aine & Cie. v. Julius Wile Sons & Co., Inc.*, 161 F.Supp. 545, 547-48 (D.N.Y. 1958) (stating that “the selection and purchase of a creme de menthe cordial generally involves an exercise of personal taste and purchasers of such liqueurs are apt to buy with a greater degree of sophistication and care than might be true in their purchase of other merchandise. Such a consideration is always relevant in appraising the likelihood of confusion.”); *G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 1295 (Fed. Cir. 1990) (“Mumm markets its product as a premium good: the purchaser of Mumm champagne can be presumed to be in the market for an upscale item for consumption and to have a reasonably focused need. Desnoes does not market its product as a premium good. These differences weigh against a holding of a likelihood of confusion.”).

Here, given the self-limiting “festival” aspect of the cited goods and services, it is submitted that consumers who desire to physically seek out and attend the discrete “festival” event utilize careful consideration to effectively research when and where the “festival” event will take place – so that they can engage in the desired commercial transaction. In exercising this type of careful consideration, “the reasonably prudent person standard is elevated to the standard of the ‘discriminating purchaser.’” *Weiss Associates, Inc. v. HRL Associates, Inc.*, 14 USPQ2d 1840, 1841 (Fed.Cir. 1990). Applicant submits that this situation is not unlike other well-known events or festivals, such as fans of The Grateful Dead musical group planning to attend specific concert

performances of the band at discrete venues. For example, such consumers would exercise this type of discriminating consumer process to ensure that they purchased tickets to attend their desired show or event – as opposed to “any” band concert. Similarly, such buyers who seek out and attend festival events are likewise keenly aware of the function and performance of the goods and services they are looking to purchase. Such consumers rarely buy on impulse, instead buying based on information or experience relating to the quality of a particular source of the goods/services (or the subject matter or “theme” of the given festival) – the more careful the typical potential purchaser is expected to be, reducing the likelihood of confusion. Kirkpatrick, *Likelihood of Confusion in Trademark Law*, Section 6.5. See also *Camacho Cigars, Inc. v. Compania Insular Tabacalera, S.A.*, 171 U.S.P.Q. 673, 674 (D.D.C. 1971) (discussing cigars and stating “[b]uyers of these high-priced cigars are not impulsive buyers, stimulated by monotonous TV advertising; but they are careful, well-informed buyers and, like the dealers in cigars, those that promote the sale of cigars in high-class cigar store counters, are basically experts in the cigar field.”).

Like the cigar purchasers in *Camacho*, Applicant respectfully contends that the typical purchaser of Applicant’s goods and services is “persuaded principally by the quality of the products or services and its intended use rather than the source of supply,” thus further decreasing any possible confusion. *General Motors Corp. v. Cadillac Marine and Boat Co.*, 226 F. Supp. 716 (W. D. Mich. 1964). For the foregoing reasons, Applicant respectfully submits that the level of discrimination of the consumers of these applicable goods and services dictates that the likelihood of confusion is further reduced,

thus requiring reversal of the present rejection(s) under Section 2(d).

V. CONCLUSION

In view of the foregoing and the available records, there is no likelihood of confusion between Applicant's mark and the cited registrations and Applicant's mark should not have been refused registration on the Principal Register under Trademark Act Sections (2)d. Accordingly, Applicant hereby submits this timely ex parte appeal brief under TMEP 1501.02(a) and respectfully requests the Board reverse the refusal of the Examining Attorney and allow the mark to pass publication.

Respectfully submitted,

Date: May 26, 2015


By: _____
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EXHIBIT A




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Dictionary


festival
adjective fes-ti-val \fes-to-vəl\

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Definition of FESTIVAL

: of, relating to, appropriate to, or set apart as a festival

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Origin of FESTIVAL

Middle English, from Anglo-French, from Latin *festivus* festive
First Known Use: 14th century

Other Performing Arts Terms

diva, dramaturgy, loge, prestidigitation, proscenium, supernumerary, zany

Rhymes with FESTIVAL

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festival
noun

: a special time or event when people gather to celebrate something

: an organized series of performances

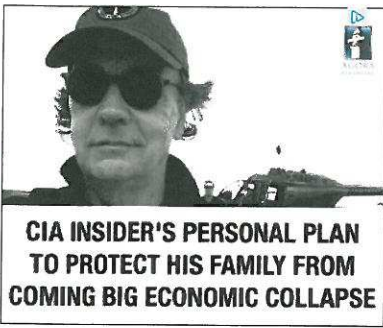
Full Definition of FESTIVAL

1 a : a time of celebration marked by special observances
b : FEAST 2


2 : an often periodic celebration or program of events or entertainment having a specified focus <a daffodil festival> <a Greek festival>


3 : GAIETY, CONVIVIALITY

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The town has a summer *festival* in the park.

First Known Use of FESTIVAL

1528

Related to FESTIVAL

Synonyms





carnival, celebration, fest, festivity, fete (or fête), fiesta, gala, jubilee

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Other Performing Arts Terms

diva, dramaturgy, loge, prestidigitation, proscenium, supernumerary, zany

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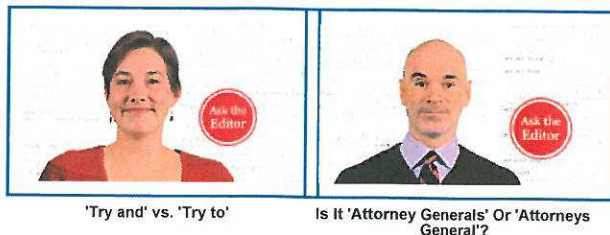
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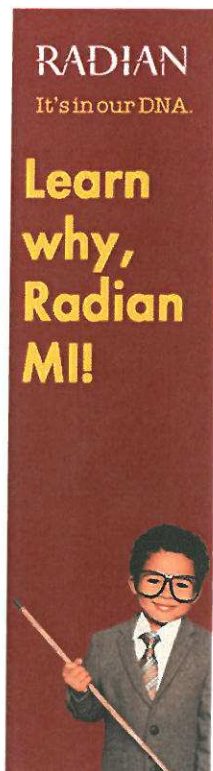
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